REPLY UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER 2600
Docket No. 1293.1861

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kiu-hae JUNG et al.

Application No. 10/673,402 Group Art Unit: 2627

Confirmation No. 3744

Filed: September 30, 2003 Examiner: Peter Vincent Agustin

For: INFORMATION STORAGE MEDIUM AND METHOD OF RECORDING/REPRODUCING THE SAME

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION AND RESTARTING OF PERIOD FOR RESPONSE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner allowed the present application on December 30, 2008, in response to the Amendment of November 10, 2008. Mark Powell, Director, Technology Center 2600, withdrew the application from issue on February 2, 2009. The Examiner issued a Final Office Action on February 6, 2009. However, it is submitted that the finality of the Final Office Action of February 6, 2009, is premature for at least the following reasons.

The Final Office Action of February 6, 2009, contains a new ground of rejection of claims 1, 2, 8, 11, 27, 29-31, 36, and 37 under 35 USC 102(b) as being anticipated by Shigenobu et al. (Shigenobu) (U.S. Patent No. 5,917,792), which was newly cited by the Examiner in the Final Office Action of February 6, 2009. On page 6 of the Final Office Action of February 6, 2009, the Examiner states as follows:

> Applicant's amendment filed on November 10, 2008
> necessitated the new ground of rejection presented in this Office

> action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

However, it is submitted that the new ground of rejection of claims 1, 2, 8, 11, 27, 29-31, 36, and 37 under 35 USC 102(b) as being anticipated by Shigenobu in the Final Office Action of February 6, 2009, was not necessitated by the Amendment of November 10, 2008, as alleged by the Examiner, but was necessitated by the Examiner's allegedly improper allowance of the application in response to the Amendment of November 10, 2008. Accordingly, it is submitted that the finality of the Final Office Action of February 6, 2009, is premature pursuant to MPEP 706.07(a), and pursuant to MPEP 706.07(c), it is respectfully requested that the finality of the Final Office Action of February 6, 2009, be withdrawn pursuant to MPEP 706.07(d).

Furthermore, the only changes to the claims that were made in the Amendment of November 10, 2008, were the amendments of independent claim 1 and 27 (the only independent claims) to recite the following additional features:

> the information storage medium is a read-only information storage medium, and
>
> the additional data area is provided to make the read-only information storage medium compatible with a recordable information storage medium.

The Examiner states as follows in the Final Office Action of February 6, 2009:

> In regard to claim 1, Shigenobu et al. disclose . . . the information storage medium is a read-only information storage medium (column 17, lines 7-9: "recording medium comprising a preamble part intended exclusively for playback, such as a DVD").
>
> Furthermore, in regard to the limitation that "the additional data area is provided to make the read-only information storage medium compatible with a recordable information storage medium", it should be noted that this is merely a recitation of intended use that neither limits the scope and/or effect of the claim language nor limits the structure of the claimed information storage medium, and therefore is not given patentable weight. See MPEP §2111.04.
>
> . . . .
>
> Claims 27, 30 & 31 have similar limitations as claims 1, 8 & 11 and are rejected on the same grounds.

Thus, the Examiner has not relied on Shigenobu to show the feature "the additional data area is provided to make the read-only information storage medium compatible with a recordable information storage medium" that was added to claims 1 and 27 in the Amendment of November 10, 2008. Accordingly, it is submitted that the new ground of rejection of claims 1, 2, 8, 11, 27, 29-31, 36, and 37 under 35 USC 102(b) as being anticipated by Shigenobu in the Final Office Action of February 6, 2009, was not necessitated by the amendment of claims 1 and 27 to include this feature in the Amendment of November 10, 2008, as alleged by the Examiner.

Furthermore, although the Examiner has relied on column 17, lines 7-9, of Shigenobu to show the feature "the information storage medium is a read-only information storage medium" that was added to claims 1 and 27 in the Amendment of November 10, 2008, it is submitted that the Examiner was not required to rely on Shigenobu to show this feature because Ho et al. (Ho) (U.S. Patent No. 6,249,896) relied on by the previous Examiner in the rejections of claims 4, 7, 8, 11, 30, 31, 36, and 37 in the Office Action of November 10, 2008, appears to disclose this feature. See, for example, column 1, lines, 24-33, of Ho, which states as follows (emphasis added):

> Increasing data bandwidth requirements of PCs has driven development of the higher-speed DVD-ROM readers or drives. Limitations of the technology such as a fixed wavelength of the laser and wobble of the disk as it spins cause data errors at the higher speeds. While the physical data on the disk may be correct, the higher rotational and reading speeds may introduce errors such as jitter. These higher-speed DVD-ROM drives may need to slow down and re-read data sectors when errors are encountered. Re-reading the data defeats the benefits of higher-speed drives.

It is submitted that the "DVD-ROM" referred to in this passage of Ho is an example of the "recording medium comprising a preamble part intended exclusively for playback, such as a DVD" referred to in column 17, lines 7-9, of Shigenobu relied on by the current Examiner in the new ground of rejection of claims 1, 2, 8, 11, 27, 29-31, 36, and 37 under 35 USC 102(b) as being anticipated by Shigenobu in the Final Office Action of February 6, 2009. Accordingly, it is submitted that this new ground of rejection was not necessitated by the amendment of claims 1 and 27 to include the feature "the information storage medium is a read-only information storage medium" in the Amendment of November 10, 2008, as alleged by the Examiner.

Since the new ground of rejection of claims 1, 2, 8, 11, 27, 29-31, 36, and 37 under 35 USC 102(b) as being anticipated by Shigenobu in the Final Office Action of February 6, 2009, was not necessitated by the amendment of claims 1 and 27 in the Amendment of November 10, 2008, for at least the reasons discussed above, it is submitted that the finality of the Final Office Action of February 6, 2009, is premature pursuant to MPEP 706.07(a). Accordingly, pursuant to MPEP 706.07(c), it is respectfully requested that the finality of the Final Office Action of February 6, 2009, be withdrawn pursuant to MPEP 706.07(d).

Furthermore, MPEP 710.06 states as follows in pertinent part:

> Where the citation of a reference is incorrect or an Office action contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2-month period for reply. The new period for reply must be at least 1 month and would run from the date the error is corrected.

Here, it is submitted that the premature finality of the Final Office Action of February 6, 2009, is an error that affects the applicants' ability to reply to the Final Office Action of February 6, 2009, pursuant to MPEP 710.06 because, *inter alia*, 37 CFR 1.116 limits the applicants' ability to amend the claims when replying to a Final Office Action. Accordingly, pursuant to 710.06, it is respectfully requested that the period for response be restarted.

If there are any additional fees associated with the filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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Date: 02/27/09

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